



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No. : 10/705,944
First Named Inventor : Yuri LI et al.
Filed : November 13, 2003
TC/A.U. : 1642
Examiner : Misook YU
Docket No. : 029065.48885D1
Customer No. : 23911
Title : Methods for Detecting for The Presence of Tumor Cells and for Screening for Anti-Tumor Agents

REPLY TO OFFICE ACTION

Mail Stop AMENDMENT
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

I hereby certify that this document is being deposited with the with the United States Postal Service as First Class Mail addressed to Mail Stop Amendment, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, on this 19th day of March, 2007.

(Signature)

Sir:

This Reply is submitted in response to the Official Action mailed December 18, 2006 in connection with the captioned patent application. A shortened statutory response to the Official Action was set to expire one (1) month from the mailing date, i.e., January 18, 2007. Applicants request a two month extension of time for submission of this Reply. Submitted herewith is a Credit Card Payment form authorizing payment of the fee under 37 CFR §1.17(a)(2). Any additional fees necessitated by this Reply may be charged to Deposit Account No. 05-1323 (Docket No. 029065.48885D1). Accordingly, this Reply is timely filed.

The Examiner required restriction to one of the following Groups of claims:

- I. Claims 21, 22, 31, and 32, drawn to a kit comprising an agent for detecting nucleic acids;
- II. Claims 23-30 and 33-40, drawn to a kit comprising an agent for detecting protein;
- III. Claim 19, drawn to a method of screening an anti-tumor agent;
- IV. Claims 41-50, drawn to an antibody that reacts with VEGF-B₁₆₇ but not VEGF-B₁₈₆;

- V. Claims 51-60, drawn to an antibody and pharmaceutical composition comprising an antibody that reacts with VEGF-B₁₈₆ but not VEGF-B₁₆₇;
- VI. Claim 62, drawn to a method of inhibition using a VEGF-B₁₆₇-specific antibody;
- VII. Claim 63, drawn to a method of inhibition using a VEGF-B₁₆₇-specific small molecule;
- VIII. Claim 64, drawn to a method of using a VEGF-B₁₆₇-specific antisense molecule;
- IX. Claims 68 and 74, drawn to a method of inhibition using a VEGF-B₁₈₆ specific antibody;
- X. Claims 69 and 75, drawn to a method of inhibition using a VEGF-B₁₈₆ specific small molecule; and
- XI. Claim 70 and 76, drawn to a method of using a VEGF-B₁₈₆ specific antisense molecule.

Moreover, the Examiner argued that claims 17, 18, and 20 link inventions I and II, claims 61, 65, and 66 link inventions VI-VIII, and claims 67, 71, 72, 73, 77-79 link inventions IX-XI. The Examiner also required an election of label or treatment species.

Applicants provisionally elect the claims of Group V for further prosecution. Also provisionally elected is FITC as the label species. This election is made with traverse for the reasons set forth below.

According to MPEP § 808, every requirement to restrict has two aspects: (a) the reasons why each invention as claimed is either independent or distinct from the other; *and* (b) the reasons why there would be a serious burden on the examiner if restriction is not required. Moreover, restriction is not proper per se only because one or more independent and distinct inventions are defined by the claims. The Examiner must explain why examining each of those inventions would impose a serious burden. In this case, the Examiner argued that the restriction is proper as

it would impose a serious burden to examine all of the claims at once because the inventions have allegedly acquired a separate status in the art in view of their different classification and the necessity for non-coextensive non-patent literature searches.

However, Applicants note that at least Groups IV, V, VI, and IX are linked by an inventive concept, i.e., isoform-specific VEGF-B antibodies and their uses. Therefore, a search of VEGF-B antibodies, specific for one isoform or the other, would necessarily uncover the art related to the use of those antibodies if such art is available. While this search might require a review of more than one class and subclass (indeed, by the Examiner's original classification scheme only two classes and subclasses were identified for all of the claims in these Groups), it would not impose a serious burden on the Examiner and it would certainly save administrative costs associated with pursuing the individual groups of claims in separate divisional filings. Therefore, reconsideration and withdrawal of the restriction requirement are requested in view of the foregoing remarks.

If there are any questions regarding this response or the application in general, a telephone call to the undersigned at (212) 895-4221 would be appreciated since this should expedite the prosecution of the application for all concerned. If necessary please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (Docket # 029065.48885D1).

Respectfully submitted,

March 19, 2007



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